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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,006	07/17/2003	Prem Vakharia	0ekm-104935	1668

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EXAMINER

MAI, TRI M

ART UNIT	PAPER NUMBER
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3781

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/622,006

Applicant(s)

VAKHARIA ET AL.

Examiner

Tri M. Mai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 2,9 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/31/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

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1. Claims 2, 9, and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention as previously set forth.

2. Claims 1, 6, and 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Harding (3861434). Harding teaches a head cover having a cover body defining an inner compartment, and a magnetic fastener 29 positioned about the opening as claimed.

Regarding claim 10, the magnet portions can engage one another as claimed.

3. Claim 1, and 3-5 are rejected under 35 U.S.C. 102 (b) as being anticipated by White (4858361). White teaches a cover defining an inner compartment, and a magnetic fastener about the opening as claimed.

Regarding claim 5, note the sleeve in Fig. 4.

4. Claims 1, 6, and 10 are rejected under 35 U.S.C. 102 (b) as being anticipated by Chang (482943). Chang teaches a cover body with a magnetic fastener as claimed.

Regarding claim 10, note the two layers in figure 8.

5. Claims 1, and 3-5 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Rosenow (3145749) in view of Russell (3161932) or Kurt (308209). Rosenow teaches a head cover with a fastener being a zipper 15. It would have been obvious for one of ordinary skill in the art to provide the magnetic fastener in Rosenow as taught by either Russell or Kurt to provide an alternative fastener.

Regarding claim 5, it would have been obvious for one of ordinary skill in the art to provide at least four magnets in each strip to provide the desired amount of magnets for securely closing the closure.

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6. Claims 6, 7, 10, 12, and 13 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the Rosenow rejection above in paragraph 5, and further in view of Lauretti (2422245). It would have been obvious for one of ordinary skill in the art to provide a liner as taught by Lauretti to provide added protection.

7. Claim 8 is rejected under 35 U.S.C. 103 (a) as being unpatentable over the Rosenow rejection as set forth above in paragraph 7, and further in view of Halter (2705039) or Workman (4784248). It would have been obvious for one of ordinary skill in the art to provide wire disposed within piping 35 to provide added rigidity.

8. Claims 1, 3-7, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lauretti in view of Russell (3161932) or Kurt. Lauretti teaches a head cover with a fastener being a zipper 15. It would have been obvious for one of ordinary skill in the art to provide the magnetic fastener in Lauretti as taught by either Russell or Kurt to provide an alternative fastener.

Regarding claim 5, it would have been obvious for one of ordinary skill in the art to provide at least four magnets in each strip to provide the desired amount of magnets for securely closing the closure.

9. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Lauretti rejection as set forth above, and further in view of Berglof et al. (5682653). It would have been obvious to one of ordinary skill in the art to provide the magnets in a heat shrink tubing as taught by Berglof to provide an alternative structure for the holding the magnets.

Regarding claim 15, it would have been obvious to one of ordinary skill in the art to provide an elastic cords having the magnetic strips to provide another alternative holding means for the magnets.

10. Claims 1, 2, 7, 10, 12, and 16 are rejected under 35 U.S.C. 102(f) as being anticipated by Japan (2003-225335A). Japan '335A teaches a head cover with a magnetic fastener as claimed. To the degree applicant submitting the IDS showing evidence that the invention as claimed may be not of applicant's since the Japanese reference has a much earlier date.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. With respect to the Harding '434 reference. Applicant asserts that the magnets in Harding are not positioned about the opening. Furthermore, applicant asserts that the magnets in Harding "at least partially shut the opening". It is submitted that Harding '343 teaches the magnets "are disposed in the tubular leg portion **adjacent** the outer end thereof" (col. 2, ln. 18-19, emphasis added). Harding clearly teaches the magnets being positioned about the opening. Furthermore, according to the dictionary: about can be defined as "in the vicinity or near". Clearly, the magnets in Harding is positioned about the opening as defined. With respect to the limitation "at least partially shut the opening", note in Fig. 1 that the tubular portion of the tube 5 is partially contracted at 2. Thus the opening is at least partially shut as claimed.

Regarding claim 10, it is noted that the magnetic fasteners as claimed do not directly engage one another. Instead, there is a liner between the two fasteners. Similar to that of applicant's, the magnets in Harding whether without the gold club between or with the golf club shaft between meet the claimed limitation as claimed.

With respect to the White reference, applicant asserts that the cover in is nonanalogous art. The examiner submits that the arguments with respect to nonanalogous art is only pertinent in 103 rejections. In this case of anticipation, the cover of White is capable of the intended use as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Applicant also asserts that White does not teach an inner compartment. It is noted that White teach a compartment when the fasteners are attaches to each other.

With respect to the Chang reference, applicant asserts that that the magnets in Chang are not positioned about the opening. As set forth above, the term “about the opening” is broad. In the very least portion 42 is adjacent the opening as claimed. Furthermore, portion 20 is part of the opening, i.e., the closure. Thus portions 20 are on the opening. Furthermore, applicant asserts that the cover in is nonanalogous art, as set forth above. In this case of anticipation, the cover of White is capable of the intended use as claimed, i.e., it can hold a removable head of a gold club as claimed similar to that of Reynolds, Jr (5388827). Furthermore, the claim does not impart any structure over the device in Chang.

With respect to the rejections of Rosenow and Russell and with Lauretti and Russell, applicant asserts that that there is no motivation for combining the references and that the Russell reference is not within the field of endeavor. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

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invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one to find that provide alternative fasteners joining two pieces of material together is within the skill of one of ordinary in the art, e.g. zippers, snap fasteners, hook and loop fasteners, etc. In this case, Russell in col. 1, ln. 10-15, discuss about the difficulty with other types of zippers and seeks to provide an improvement by providing magnetic fasteners. Thus, to provide the zippers of either Rosenow or Lauretti with the fasteners of Russell would have been obvious. Since as set forth in Russell, these fasteners are equivalents with one another.

The declaration has also considered but they are not persuasive. The declaration can not be used to overcome 102 rejections. Furthermore, the declaration fails to provide a nexus between the invention and the claimed subject matter. The declaration focusing on the various types of heard clubs but the claimed subject matter is broadly directed only to a cover. The claims recite no combination with any golf clubs. Furthermore, applicant fails to provide any evidences and arguments cannot be substitute with evidence.

The rejections as set forth above stand.


11. Applicant's submission of an information disclosure statement prompted the new grounds of rejections with Kurt and JP'335 presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571)272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


TRI M. MAI
PRIMARY EXAMINER